

TES05-GN016
Office Action Response

REMARKS

I. Introduction

Claims 13-15 have been cancelled. A new abstract has been added to overcome the objection under 37 C.F.R. 1.72(b).

II. Detailed Action

Obviousness-Type Double Patenting Rejection

Claims 1-15 stand rejected under the judicially created doctrine of obviousness-type double patenting with respect to U.S. Patent No. 6,209,010 ("Gauthier"). Claims 13-15 have been cancelled; and, therefore, the above rejection to these claims is now moot. As will be discussed in detail below, the above ground of rejection to claims 1-12 is respectfully traversed.

Independent Claim 1 Features are Patentably Distinct

It is respectfully submitted that independent claim 1 of the instant application is patentably distinct over the claims of Gauthier.

The Office action indicates on Page 3 that claim 11 of Gauthier teaches certain limitations of independent claim 1 of the present application, but does not teach "first and second text string, first and second page description language, first and second special characters, and first and second string of characters"; and later on Page 4, that Gauthier does not teach a "special attribute." The Office action thereafter alleges that the limitations not taught would have been obvious to one of ordinary skill in the art; Applicant respectfully disagrees.

Attempting to explain further, the Office action recognizes that certain limitations in claim 1 of the present application replace limitations in claim 11 of Gauthier, and further recognizes that the new limitations are *narrower* than the limitations they replace. Then, the Office action relies on a number of cases, including In re Karlson, to support the proposition that since Applicant has removed a limitation from a claim, such removal renders the claim obvious. It is respectfully submitted that Applicant does not follow this line of reasoning. Applicant

TES05-GN016
Office Action Response

agrees that merely removing a limitation from a prior claim would typically render the new claim obvious over the prior claim, *but this has not occurred in the present case*. Rather, Applicant has *replaced* a prior limitation with a new narrower limitation. Consequently, since the new narrower limitation is not taught nor suggested by Gauthier, claim 1 is not obvious over Gauthier.

To establish a *prima facie* case of obviousness-type double patenting, three basic criteria must be met. First, there must be some suggestion or motivation, either in Gauthier, the prior art, or in the knowledge generally available to one of ordinary skill in the art, to modify Gauthier or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, Gauthier (or combination of the prior patent and a prior art reference) must teach or suggest all the claim limitations of the pending claims. The teaching or suggestion to make the claimed combination and the reasonable expectation cannot be based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). To support the conclusion that the claimed invention is directed to obvious subject matter, the Office action must present a convincing line of reasoning as to why the claimed invention would have been obvious to one of ordinary skill in light of the teachings of the patent or such references. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added). But, "[when] considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art." (M.P.E.P. § 804)

The Examiner's statements that modifications of Gauthier to meet the claimed invention would have been "obvious to one of ordinary skill of the art" at the time the claimed invention was made is not sufficient to establish a *prima facie* case of obviousness without some additional reasoning and/or references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (The level of skill in

TES05-GN016
Office Action Response

the art cannot be relied upon to provide the suggestion to combine references.). (M.P.E.P. §2143)

Further, examination guidelines stipulate that an Examiner must make clear any obviousness-type double patenting rejection to include a discussion of:

- (A) The differences between a claim of the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent. (M.P.E.P. §804)

This second requirement was clearly not met in the instant Office action. No reasoning is provided other than conclusory statements as to why independent claim 1 of the instant application is alleged to be obvious with respect to claim 11 of Gauthier.

It is respectfully submitted that independent claim 1 of the instant application is patentably distinct over Gauthier. In light of the absence of requisite findings to establish a *prima facie* case of obviousness, the Examiner is respectfully requested to withdraw the obviousness-type double patenting rejection of record directed to independent claim 1.

Dependent Claims 2-4 Features are Patentably Distinct

It is respectfully submitted that dependent claims 2-4 of the instant application are also patentably distinct over the claims of Gauthier.

The Office action opines that claims 12-14 of Gauthier teach certain limitations of dependent claims 2-4 of the present application, but do not teach "first and second text string, first and second page description language, first and second special characters, and first and second string of characters", nor a "special attribute." The Office action thereafter alleges that the limitations not taught would have been obvious to one of ordinary skill in the art.

As claims 2-4 depend from independent claim 1, claims 2-4 are patentably distinct for the reasons annunciated above for patentably distinct independent claim 1. In light of the absence of

TES05-GN016
Office Action Response

requisite findings to establish a *prima facie* case of obviousness with respect to independent claim 1, the Examiner is respectfully requested to withdrawal the obviousness-type double patenting rejection of record directed to claims 2-4.

Independent Claim 5 Features are Patentably Distinct

It is respectfully submitted that independent claim 5 of the instant application is patentably distinct over the claims of Gauthier.

The Office action states that claims 15 and 19 of Gauthier teach certain limitations of independent claim 5 of the present application, but does not teach "an external bitmap and external bitmap boundary", nor a "composite boundary." The Office action thereafter alleges that the limitations not taught would have been obvious to one of ordinary skill in the art; Applicant respectfully disagrees,

With respect to Gauthier not teaching an external bitmap and an external bitmap boundary, the Office action reasons that such new limitations are obvious from Gauthier "because an external bitmap and external-bitmap boundary within Gauthier PDL environment suggests the bitmap is external to the specification." The Applicant has studied this statement at length and cannot draw any meaning from it; therefore, the Applicant respectfully requests the Examiner to explain what is meant by this statement. If the Examiner is arguing that such claimed elements are inherent in Gauthier, the Applicant respectfully traverses this inherency rejection and respectfully requests the examiner to fully provide a basis in fact and/or technical reasoning to support that the allegedly inherent characteristic necessarily flows from the teachings of Gauthier (see MPEP §2112).

With respect to Gauthier not teaching the step of adding the boundary of the external bitmap to the wrapping-path boundary to form a composite boundary, the Office action incorrectly argues that replacing a limitation in Gauthier claim 15 or 19 with a new *narrower* element (that is not taught nor suggested by Gauthier) effectively merely eliminates an element from Gauthier claim 15 or 19, rendering the new claim obvious (again citing a number of cases including In re Karlson). This argument completely runs against the well-founded principles of

TES05-GN016
Office Action Response

patent law, and is not supported by any of the cases cited. Basic patent law mandates that if the prior art teaches elements A, B, C and D; and the applicant claims elements, A, B, C and E, where this new combination is not taught nor suggest by the prior art, then this new combination of elements is *patentable* over the prior art, even if element E merely replaces prior art element D.

For at least the above reasons, therefore, it is respectfully submitted that independent claim 5 of the instant application is patentably distinct over Gauthier. In light of the absence of requisite findings to establish a *prima facie* case of obviousness, the Examiner is respectfully requested to withdrawal the obviousness-type double patenting rejection of record directed to independent claim 5.

Dependent Claim 6 Features are Patentably Distinct

As claim 6 depends from independent claim 5, claim 6 is patentably distinct for the reasons annunciated above for patentably distinct independent claim 5.

Independent Claim 7 Features are Patentably Distinct

It is respectfully submitted that independent claim 7 of the instant application is patentably distinct over the claims of Gauthier.

The Office action states that claim 15 of Gauthier teaches certain limitations of independent claim 7 of the present application, but does not teach a "field delimiter", nor a "first and second graphics state, first and second block of text, and first and second bitmap representation." The Office action thereafter alleges that the limitations not taught would have been obvious to one of ordinary skill in the art; Applicant respectfully disagrees.

Once again, the Office action alleges that claim 7 of the instant application merely replaces limitations from claim 15 of Gauthier with narrower limitations; and then incorrectly argues that by replacing a limitation of claim 15 of Gauthier with a narrower limitation, the

TES05-GN016
Office Action Response

Applicant is effectively eliminating elements from claim 15, rendering claim 7 of the instant application obvious. As discussed above, this argument completely runs against the well-founded principles of patent law, and is not supported by any of the cases cited.

Consequently, it is respectfully submitted that independent claim 7 of the instant application is patentably distinct over Gauthier. In light of the absence of requisite findings to establish a *prima facie* case of obviousness, the Examiner is respectfully requested to withdraw the obviousness-type double patenting rejection of record directed to independent claim 7.

Independent Claim 8 Features are Patentably Distinct

It is respectfully submitted that independent claim 8 of the instant application is patentably distinct over the claims of Gauthier.

The Office action opines that claim 15 of Gauthier teaches certain limitations of independent claim 8 of the present application, but does not teach a "plurality of words", nor "replacing all occurrences of a predetermined word in the text block with a substitute word." The Examiner also attempts to take Official Notice that "replacing a word with a substitute word is well known in the art at the time of the invention." The Applicant respectfully disagrees. While the "block replace" concept is notorious with respect to word processor programs, such a concept is novel to the high-speed variable data printing environment claimed by the present application. In other words, this element is not obvious in the context in which it is claimed in independent claim 8 of the instant application. Therefore, Applicant traverses the Examiner's Official Notice and requests that the Examiner provide adequate evidence to support such a conclusion (see MPEP §2144.03).

Consequently, it is respectfully submitted that independent claim 8 of the instant application is patentably distinct over Gauthier. In light of the absence of requisite findings to establish a *prima facie* case of obviousness, the Examiner is respectfully requested to withdraw the obviousness-type double patenting rejection of record directed to independent claim 8.

TES05-GN016
Office Action Response

Independent Claim 9 (and dependent claims 10-11) Features are Patentably Distinct

It is respectfully submitted that independent claim 9 of the instant application is patentably distinct over the claims of Gauthier. For at least the same reasons, it is respectfully submitted that dependent claims 10 and 11 are also patentably distinct from the claims of Gauthier.

The Office action states that claim 15 of Gauthier teaches certain limitations of independent claim 9 of the present application, but does not teach a "plurality of words", nor a "delimiter." The Office action thereafter alleges that the limitations not taught would have been obvious to one of ordinary skill in the art, because each of these elements is "within Gauthier PDL environment." Similar to the discussion above with respect to claim 5 above, Applicant respectfully submits that no meaning can be drawn from this statement; and therefore, the Applicant respectfully requests the Examiner to explain what is meant by this statement. If the Examiner is arguing that such claimed elements are inherent in Gauthier, the Applicant respectfully traverses this inherency rejection and respectfully requests the examiner to fully provide a basis in fact and/or technical reasoning to support that the allegedly inherent characteristic necessarily flows from the teachings of Gauthier (see MPEP §2112).

Consequently, it is respectfully submitted that independent claim 9 of the instant application is patentably distinct over Gauthier. In light of the absence of requisite findings to establish a *prima facie* case of obviousness, the Examiner is respectfully requested to withdrawal the obviousness-type double patenting rejection of record directed to independent claim 9. And for at least the same reasons, it is also respectfully submitted that the obviousness-type double patenting rejection be removed from dependent claims 10 and 11.

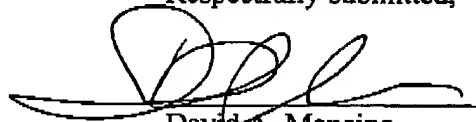
Independent Claim 12 Features are Patentably Distinct

It is respectfully submitted that independent claim 12 of the instant application is patentably distinct over the claims of Gauthier.

TES05-GN016
Office Action Response

If the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number provided below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Mancino', written over a horizontal line.

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Creation date: 07-19-2004
Indexing Officer: TLEGESSE - TSEGAYE LEGESSE
Team: OIPEBackFileIndexing
Dossier: 09436749

Legal Date: 03-31-2004

No.	Doccode	Number of pages
1	SRNT	4

Total number of pages: 4

Remarks:

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